

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* NAOMITU TANAKA, TATSUO KOYAMA  
and MASANORI SANO

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Appeal No. 2001-0731  
Application No. 08/904,868

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HEARD : May 8, 2002

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Before GARRIS, JEFFREY T. SMITH and MOORE, *Administrative Patent Judges*.  
JEFFREY T. SMITH, *Administrative Patent Judge*.

***DECISION ON APPEAL***

Applicants appeal the decision of the Primary Examiner finally rejecting claims 1, 2, 7, 9 and 11.<sup>1</sup> We have jurisdiction under 35 U.S.C. § 134.

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<sup>1</sup> Claim 3 to 6 and 13 to 16 are pending in the present application and have been withdrawn from consideration. Claim 7 has been amended and claims 10 and 12 were canceled in an amendment filed June 13, 2000. (Brief, p. 2.) The Examiner has indicated that the amendment has been entered. (Answer, p. 2.)

### ***BACKGROUND***

Appellants' invention relates to a pressure sensitive cleaning article. The pressure sensitive cleaning article comprises a substrate, a pressure sensitive adhesive layer and a porous screen disposed on the pressure sensitive layer. Claims 1 and 7, which are representative of the claimed invention, appear below:

1. A pressure-sensitive cleaning sheet comprising a substrate, a pressure-sensitive adhesive layer formed on one or both sides of the substrate, and a porous screen disposed on the pressure-sensitive adhesive layer, wherein

the cleaning sheet is substantially non-tacky when the cleaning sheet surface is kept in a non-pressed state, under which the porous screen is projecting from the surface of the pressure-sensitive adhesive layer;

the cleaning sheet exhibiting tackiness when the cleaning sheet is kept in a pressed state, under which the pressure-sensitive adhesive layer appears on the sheet surface through the openings of the porous screen; and

the cleaning sheet again becomes substantially non-tacky upon release from pressing.

7. A roll-form image-forming material having a cleaning part, the cleaning part comprising a pressure-sensitive adhesive layer having a porous screen disposed thereon, wherein

the cleaning part is substantially non-tacky when the cleaning part surface is kept in a non-pressed state, under which the porous screen is projecting from the surface of the pressure-sensitive adhesive layer;

the cleaning part exhibits tackiness when the cleaning part surface is kept in a pressed state, under which the pressure-sensitive adhesive layer appears on the cleaning part surface through the openings of the porous screen; and

the cleaning part again becomes substantially non-tacky upon release from pressing.

### ***CITED PRIOR ART***

As evidence of unpatentability, the Examiner relies on the following references:

Barough et al. (Barough)	3,889,310	Jun. 17, 1975
Gelardi et al. (Gelardi)	5,153,964	Oct. 13, 1992
Schneberger et al. <sup>2</sup> (Schneberger)	5,736,470	Apr. 7, 1998 (Filed Jun. 25, 1996)

Claims 1 and 2 are rejected as unpatentable under 35 U.S.C. § 103(a) as obvious over Schneberger and claims 7, 9 and 11 are rejected as unpatentable under 35 U.S.C. § 103(a) as obvious over the combination of Schneberger, Gelardi and Barough. (Answer, pp. 3 and 4.)

### **DISCUSSION**

We have carefully reviewed the claims, specification and applied prior art, including all of the arguments advanced by both the Examiner and Appellants in support of their

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<sup>2</sup> This reference qualifies as prior art under 35 U.S.C. § 102(e).

respective positions. This review leads us to conclude that the Examiner's § 103 rejections are not well founded.

A fatal deficiency common to all of the rejections is the Examiner's position that it would have been obvious to utilize the teachings of Schneberger to make pressure sensitive cleaning sheet with an adhesive that is substantially non-tacky upon release of pressure to allow the sheet to be repositioned.

We do not believe the Schneberger reference would have suggested that the pressure sensitive adhesive sheet would have been substantially non-tacky upon release of pressure. The Examiner asserts the porous sheet, i.e., pore size, number of pores and arrangement of pores, can be selected depending on the nature of the adhesive used. It is true that Schneberger discloses that the characteristics of the porous layer can be varied depending on the adhesive. (Col. 3, l. 63 to col. 4, l. 4.) However, we do not perceive and the Examiner has not explained why the selection of a porous layer that would have rendered the pressure sensitive sheet substantially non-tacky upon release of pressure would have obvious to one of ordinary skill in the art. The mere fact that the prior art could be modified, to select a particular porous layer, would not have made the modification obvious unless the prior art suggested the desirability of the modification. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398

(Fed. Cir. 1989). The Examiner also asserts that Schneberger teaches the pressure sensitive sheets can be repositioned and that light pressure can be used. While Schneberger discloses the pressure sensitive sheet can be repositioned, Schneberger does not disclose pressure is applied to the sheet before the repositioning of the adhesive sheet. Further, Schneberger does not indicate that the sheet would have become substantially non-tacky upon release of pressure. On the record before us, it appears the Examiner has reached this conclusion based upon impermissible hindsight derived from Appellants' own disclosure rather than some teaching, suggestion or incentive derived from Schneberger.

The Examiner relies on Gelardi and Barough, in addition to Schneberger to reject claims 7, 9 and 11. However, Gelardi and Barough do not remedy the deficiency in the pressure sensitive adhesive layer having a porous screen described by Schneberger.

### ***CONCLUSION***

For the above stated reasons, we cannot sustain any of the § 103(a) rejections before us on this appeal.

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**REVERSED**

BRADLEY R. GARRIS  
*Administrative Patent Judge*

JEFFREY T. SMITH  
*Administrative Patent Judge*

JAMES T. MOORE  
*Administrative Patent Judge*

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